

REMARKS

Claims 1-30, 31, and 35 were previously cancelled. Claims 30, 32-34, and 36-61 remain pending in the application. Reconsideration and review of the application is respectfully requested.

The Examiner rejected Claims 37-38, 42,44-45 under 35 U.S.C. § 102(b) as being anticipated by Cantone. The Examiner rejected Claims 30-34, 36-43, and 45 under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Tatebayashi et al. and further in view of Peterson, Jr. The Examiner rejected Claims 44 and 46-47 under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Tatebayashi et al. and further in view of Peterson Jr. and further in view of Abecassis. The Examiner rejected 48-51, 53, 57-59 under 35 U.S.C. § 103(a) as being unpatentable over Hendricks in view of Peterson Jr. The Examiner rejected Claim 52 under 35 U.S.C. § 103(a) as being unpatentable over Hendricks in view of Peterson Jr., and further in view of Tatebayashi et al. The Examiner rejected Claim 54-56 under 35 U.S.C. § 103(a) as being unpatentable over Hendricks in view of Peterson Jr., and further in view of Abecassis. The Examiner rejected Claims 60-61 under 35 U.S.C. § 103(a) as being unpatentable over Hendricks in view of Peterson Jr., and further in view of Russo. The Examiner rejected Claims 39-41 and 43 under 35 U.S.C. § 103(a) as being unpatentable over Cantone in view of Tatebayashi et al. The Examiner rejected Claims 46-47 under 35 U.S.C. § 103(a) as being unpatentable over Cantone in view of Tatebayashi et al., and further in view of Abecassis.

Before discussing the merits of the Examiner's rejection, a brief description of several embodiments of the present invention is provided. This discussion is provided to direct the Examiner's attention to certain embodiments supporting a number of the pending claims. This discussion is not intended to define or limit the claimed invention(s) in any way.

One embodiment of the present invention relates to a system through which users can obtain pay-per-view access to video content. (See spec. p. 2, l. 27-30). A user accesses a publicly accessible kiosk and loads video content onto a portable video

content storage device configured to securely store video content. (See spec. p. 3, l. 3-5). The portable video content storage device can be an active device such as a hard disk drive with a controller. (See spec., p. 5, l. 7-16). Alternatively, the portable video content storage device can be a passive device such as a DVD-RAM. (See spec. p. 16, l. 8- p. 17, l. 10). The user preferably accesses the video content by attaching the storage device to a compatibly configured set-top box. (See spec. p. 3, l. 5-7). In one embodiment, the storage device includes a hard disk drive on which the video content is stored and also includes an associated controller configured to prevent unauthorized access to the video stored on the hard drive. (See spec. p. 5, l. 7-10).

In one embodiment, the set top box stores use data relating the user's use of the video on the storage device. The use data is read upon a subsequent return to the kiosk so that the user can be appropriately charged. (See spec. p. 3, l. 7-13). By storing use data on the portable content storage device and transferring the use data upon a subsequent kiosk visit, there need be no direct communication link, such as a telephone line, between a billing office and the user's home.

Turning now to a discussion of the references cited by the Examiner, Cantone discloses a digital videocassette for digitally storing compressed video and audio data. and an interface means for playing back the stored data in analog format through a conventional videocassette recorder. The Cantone videocassette has a data port with an internal modem for communications with a video server. Cantone also discloses downloading content from a video store or telephonically. However, Cantone does not disclose an interactive kiosk from which video content can be downloaded.

Allen discloses a user kiosk configured to store video content at high speed on videotapes or DVDs. Allen relates to the creation and distribution of video content, but does not address preventing unauthorized access to video content. Furthermore, Allen does not disclose a controller configured to prevent unauthorized access to the videotapes or DVDs.

Tatebayashi discloses a system for preventing the unauthorized manipulation of video or other proprietary content. A reception (verifier) device is configured to receive

and decode a video signal. The reception device is further configured to output the received and decoded signal only to certain authorized or verified devices, called claimant devices, through the use of a verification procedure. By verifying the claimant devices, only certain claimant devices can be configured for receipt of the proprietary content from the receiver device. Accordingly, a DVD-RAM claimant may be authorized to create DVDs from the signal but a personal computer might not be so authorized in order to prevent digital manipulation of the received proprietary content.

Tatebayashi, however, only discloses a verification through which the receiver/verifier verifies the claimant device. The verifier device of Tatebayashi does not include a mass storage module and accordingly does not include any controller configured to prevent unauthorized access to a mass storage module. The claimant device itself does not perform any verification function and there is no teaching or suggestion in Tatebayashi of configuring the claimant device to limit access in any way. Tatebayashi does appear to disclose a small or portable DVD-RAM device which could be used to write video to a DVD-RAM. Tatebayashi does not, however, disclose any controller configured to prevent unauthorized access to a DVD-RAM.

Peterson, Jr. discloses a system for allowing time based access to audio and video content. In the system of Peterson, Jr., authorization to view prerecorded audio and/or video content is gained by secure card. (Col. 8, l. 18-22, Col. 8, l. 62-65). Certain authorization and use information is stored on the secure card. Peterson, Jr. does not disclose writing content use information to or reading content use information from a portable video content storage device.

Hendricks discloses a set top box that supports an expanded television program delivery system, which allows viewers to select programs from menus. In Figure 5a, Hendricks shows a set top box with a cartridge opening 635 that allows the set top box to be reprogrammed locally with the use of a magnetic tape cartridge. (Col. 15, l. 8-14). Hendricks does not, however, disclose the use of a portable video content storage device.

Turning now to the merits of the Examiner's rejections:

Regarding Claims 30, 32-33:

Independent Claim 30 was rejected by the Examiner as obvious over Allen in view of Tatebayashi in further view of Peterson Jr. Applicants respectfully traverse this rejection. The combination of references cited by the Examiner does not disclose all of the elements of Claim 30. Notably, while Allen discloses a kiosk, that kiosk is not "configured to read content use data from the portable video content storage device," as recited in Claim 30. In contrast, the kiosk disclosed by Allen verifies the content of a returned video cassette without reading content use data (further, Allen does not disclose storing content use data on the videocassettes used in its system). (Allen, Col. 24, l. 1-8). Allen discloses a system in which the content use data is not recorded; rental billing is based solely on the time the video cassette was away from the kiosk. (Allen, Col. 24, l. 5-8).

Additionally, none of the cited references discloses a system in which "a set-top box is configured to write content use data to the portable video content storage device, and wherein the interactive kiosk is further configured to read content use data from the portable video content storage device." Peterson Jr. is cited by the Examiner as disclosing the claim element that the set-top box is configured to "write content use data to the portable video content storage device." But, Peterson Jr. discloses prerecorded "non-alterable, non-volatile read only control data recorded on the DVD, CD-ROM, CD, game cartridges and other electronic media." (Peterson Jr., Col. 3, l. 7-10). Peterson Jr. also discloses the use of a separate secure card to store customer identification information, date and time information, and content viewing authorizations (Peterson Jr., Col. 5, l. 59- Col. 6, l. 22, Col. 8, l. 19-65). Therefore, Peterson does not disclose a system that reads or writes content use information to a portable video content storage device. Rather, content use information is written to a separate secure card such as a smart card or a PCMCIA card.

Since the combination of references suggested by Examiner does not disclose all of the elements of Claim 30, Applicants respectfully submit that Claim 30 is allowable.

Claims 32 and 33 depend from Claim 30 and should be likewise allowable for at least the reasons set forth above with respect to Claim 30. Furthermore, these dependent claims also recite additional patentable distinctions above the cited art.

Regarding Claims 34, 36:

Independent Claim 34 was rejected by the Examiner as obvious over Allen in view of Tatebayashi in further view of Peterson Jr. For at least the reasons discussed above regarding Claim 30, Applicants submit that Claim 34 is allowable. Specifically, none of the references cited by the Examiner disclose the claimed step of "writing content use data to the portable video content storage device."

Claim 36 depends from Claim 34 and should be likewise allowable for at least the reasons set forth above with respect to Claim 34. Furthermore, this dependent claim also recites additional patentable distinctions above the cited art.

Regarding Claims 37-47:

Independent Claim 37 was rejected by the Examiner as obvious over Allen in view of Tatebayashi in further view of Peterson Jr. Claim 37 recites "a controller configured to prevent unauthorized access to the mass storage module," and "further configured to permit video content to be written to the mass storage module by a compatibly configured interactive kiosk." Claim 37 further recites that "the mass storage module and the controller," are contained in a "hand-held housing." These limitations are not disclosed by the combination of references cited by the Examiner. Allen merely discloses the recording of data onto videocassettes or DVDs with the use of kiosks. These videocassettes or DVDs do not comprise hand-held housings containing a controller and a mass storage module.

Neither Tatebayashi nor Peterson Jr. discloses the writing of video content to a mass storage module from a kiosk or other media source. In contrast, these two references disclose various aspects of playback of prerecorded encoded media. Tatebayashi discloses a system to limit devices to which a video signal is proffered.

Tatebayashi does not disclose a controller configured to permit video content to be written to a mass storage device. Rather the Tatebayashi devices include a verifier control unit and a claimant control unit (Tatebayashi, Col. 13, l. 23-26) that allow a communication link to be created only between authorized devices. The system of Tatebayashi discloses reading data from a storage device once the communication link has been created (rather than writing data to a mass storage module). Likewise, Peterson Jr. discloses reading data from a prerecorded CD-ROM or DVD once playback of the media has been authorized. (Peterson Jr., Col. 2, l. 46-61). As noted above with respect to Claim 30, Peterson Jr. discloses a controller that is not integrated with the recorded media in a hand held housing (rather, a separate secure card, or, alternately, a component of a computing device, authorizes access to the prerecorded CD or DVD media). Therefore, since several of the limitations of Claim 37 are not present in the combination of references suggested by the Examiner, Applicants submit that this rejection should be withdrawn.

The Examiner also rejected Claim 37 as being anticipated by Cantone. However, as noted above, Cantone does not disclose "a compatibly configured interactive kiosk" from which video content is written to the mass storage module. Rather, Cantone discloses asking a video store employee to download data through the data port of the videocassette (Cantone, Col. 5, l. 46-57) and a user telephonically accessing a rental agency or video server database (Cantone, Col. 6, l. 46-51). Therefore, since Cantone does not disclose all of the elements of Claim 37, Applicants submit that the rejection based on Cantone should be withdrawn.

Claims 38-48 depend from Claim 37 and should be likewise allowable for at least the reasons set forth above with respect to Claim 37. Furthermore, these dependent claims also recite additional patentable distinctions above the cited art.

As to Claims 48-56:

Independent Claim 48 was rejected by the Examiner as being unpatentable over Hendricks in view of Peterson Jr. Applicants respectfully traverse this rejection. The

cited combination of references does not disclose all of the elements of the claimed invention. While Hendricks discloses a flapped opening 635 allowing the insertion of a magnetic cartridge, this flapped opening does not "receive the portable video content storage device," as recited in Claim 48. Rather, the flapped opening allows firmware upgrades and reprograms to be uploaded to the set-top terminal. (Hendricks, Col. 15, l. 8-13). Also, as discussed above with respect to Claim 30, Peterson Jr. does not disclose a processor configured to "store the accumulated content use data on the portable video content storage device," as recited in Claim 30. In contrast, Peterson Jr. discloses prerecorded video and/or audio data on DVDs or CD-ROMs in addition to certain consumer data being stored on a separate secure card. There is no disclosure in Peterson Jr. that the secure card stores any video content in addition to this consumer data. Applicants submit that for at least the foregoing reasons, the rejection of Claim 48 should be withdrawn.

Claims 49-56 depend from Claim 48 and should be likewise allowable for at least the reasons set forth above with respect to Claim 48. Furthermore, these dependent claims also recite additional patentable distinctions above the cited art.

As to Claims 57-61:

Independent Claim 57 was rejected by the Examiner as being unpatentable over Hendricks in view of Peterson Jr. Applicants respectfully traverse this rejection. For at least the reasons discussed above with respect to Claim 48, Applicant submits that the combination of references cited by the Examiner does not disclose all of the elements of Claim 57. Specifically, the steps of "receiving in a user accessible receptacle a portable video content storage device storing video content" and "transferring the present content use data onto the portable video storage device" are not disclosed by either of the references cited by the Examiner. Applicants therefore request that the rejection of Claim 57 be withdrawn.

Serial No. 09/506,261

July 1, 2004

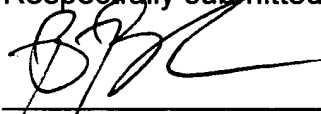
Page 16

Claims 58-61 depend from Claim 57 and should be likewise allowable for at least the reasons set forth above with respect to Claim 57. Furthermore, these dependent claims also recite additional patentable distinctions above the cited art.

In view of the foregoing remarks, Applicants submit that the application is in condition for allowance. If, however, issues remain which can potentially be resolved by telephone, the Examiner is invited to call the undersigned attorney of record at the telephone number indicated below.

A check in the amount of \$1,140.00 is enclosed for the three-month extension of time (\$475.00) pursuant to 37 CFR §1.17(a)(3), and for Petition to Revive (\$665.00) pursuant to 37 C.F.R. § 1.137(b). The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,



Date: July 1, 2004

Brian M. Berliner
Attorney for Applicants
Registration No. 34,549

O'MELVENY & MYERS LLP
400 South Hope Street
Los Angeles, California 90071-2899
Telephone: (213) 430-6000